

MAR 30 2004

Atty Docket No. 015280-397100US

PTO FAX NO.: (703) 872-9306

ATTENTION: Examiner Maher M. Haddad  
TELEPHONE NO.:

Group Art Unit 1644

**OFFICIAL COMMUNICATION  
FOR THE PERSONAL ATTENTION OF  
EXAMINER Maher M. Haddad**

**CERTIFICATION OF FACSIMILE TRANSMISSION**


I hereby certify that the following document(s) in re Application of ROBERTS and KRUTZSCH, Application No. 10/030,735, filed January 9, 2002 for PEPTIDES AND THEIR UTILITY IN MODULATION OF BEHAVIOR OF CELLS EXPRESSING A3B1 INTEGRINS is being facsimile transmitted to the Patent and Trademark Office on the date shown below.

Document(s) Attached

1. Response to Restriction Requirement;
2. Petition for Extension of Time Under 37 CFR 1.136(a);
3. Fee Transmittal Form

Number of pages being transmitted, including this page: 8

Dated: March 30, 2004

  
Pamela Skelton

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RETURN FACSIMILE AT (415) 576-0300**

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, Eighth Floor  
San Francisco, CA 94111-3834  
Telephone: 858-350-6100  
Fax: (858) 350-6111  
60178641 v1

# FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 55.00

Complete If Known

Application Number 10/030,735  
 Filing Date January 9, 2002  
 First Named Inventor David D. Roberts, et al.  
 Examiner Name Maher M. Haddad  
 Art Unit 1844  
 Attorney Docket No. 015280-397100US

PTO/SB/17 (10-03)

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MAR 30 2004

**METHOD OF PAYMENT (check all that apply)**

☐ Check ☐ Credit Card ☐ Money Order ☐ Other ☐ None

☒ Deposit Account:

Deposit Account Number 20-1430

Deposit Account Name Townsend and Townsend and Crew LLP

The Director is authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☒ Credit any overpayments

☒ Charge any additional fee(s) or any underpayment of fee(s)

☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

**FEE CALCULATION**

**1. BASIC FILING FEE**

| Large Entity        | Small Entity | Fee Code | Fee (\$) | Fee Description        | Fee Paid |
|---------------------|--------------|----------|----------|------------------------|----------|
| 1001                | 2001         | 770      | 385      | Utility filing fee     |          |
| 1002                | 2002         | 340      | 170      | Design filing fee      |          |
| 1003                | 2003         | 530      | 285      | Plant filing fee       |          |
| 1004                | 2004         | 770      | 385      | Reissue filing fee     |          |
| 1005                | 2005         | 160      | 80       | Provisional filing fee |          |
| <b>SUBTOTAL (1)</b> |              |          |          |                        | \$5.00   |

**2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE**

| Total Claims | Extra Claims | Fee from below | Fee Paid |
|--------------|--------------|----------------|----------|
|              |              |                |          |
|              |              |                |          |
|              |              |                |          |

| Large Entity        | Small Entity | Fee Code | Fee (\$) | Fee Description   | Fee Paid |
|---------------------|--------------|----------|----------|---|----------|
| 1202                | 2202         | 18       | 9        | Claims in excess of 20                                  |          |
| 1201                | 2201         | 88       | 43       | Independent claims in excess of 3                       |          |
| 1203                | 2203         | 290      | 145      | Multiple dependent claim, if not paid                   |          |
| 1204                | 2204         | 88       | 43       | Reissue independent claims over original patent         |          |
| 1205                | 2205         | 18       | 9        | Reissue claims in excess of 20 and over original patent |          |
| <b>SUBTOTAL (2)</b> |              |          |          |   | \$       |

\*\*or number previously paid, if greater; For Reissues, see above

**FEE CALCULATION (continued)**

**3. ADDITIONAL FEES**

| Large Entity                      | Small Entity | Fee Code | Fee (\$) | Fee Description  | Fee Paid |
|-----------------------------------|--------------|----------|----------|--|----------|
| 1051                              | 2051         | 130      | 65       | Surcharge - late filing fee or oath  |          |
| 1052                              | 2052         | 50       | 25       | Surcharge - late provisional filing fee or cover sheet                     |          |
| 1053                              | 1053         | 130      | 130      | Non-English specification  |          |
| 1812                              | 1812         | 2,520    | 2,520    | For filing a request for reexamination                                     |          |
| 1804                              | 1804         | 920*     | 920*     | Requesting publication of SIR prior to Examiner action                     |          |
| 1805                              | 1805         | 1,840*   | 1,840*   | Requesting publication of SIR after Examiner action                        |          |
| 1251                              | 2251         | 110      | 55       | Extension for reply within first month                                     | 55.00    |
| 1252                              | 2252         | 420      | 210      | Extension for reply within second month                                    |          |
| 1253                              | 2253         | 950      | 475      | Extension for reply within third month                                     |          |
| 1254                              | 2254         | 1,480    | 740      | Extension for reply within fourth month                                    |          |
| 1255                              | 2255         | 2,010    | 1,005    | Extension for reply within fifth month                                     |          |
| 1401                              | 2401         | 330      | 165      | Notice of Appeal   |          |
| 1402                              | 2402         | 330      | 165      | Filing a brief in support of an appeal                                     |          |
| 1403                              | 2403         | 290      | 145      | Request for oral hearing   |          |
| 1451                              | 1451         | 1,510    | 1,510    | Petition to institute a public use proceeding                              |          |
| 1452                              | 2452         | 110      | 55       | Petition to revive - unavoidable   |          |
| 1453                              | 2453         | 1,330    | 665      | Petition to revive - unintentional   |          |
| 1501                              | 2501         | 1,330    | 665      | Utility issue fee (or release)   |          |
| 1502                              | 2502         | 480      | 240      | Design issue fee   |          |
| 1503                              | 2503         | 640      | 320      | Plant issue fee  |          |
| 1460                              | 1460         | 130      | 130      | Petitions to the Commissioner  |          |
| 1807                              | 1807         | 50       | 50       | Petitions related to provisional applications                              |          |
| 1806                              | 1806         | 180      | 180      | Submission of Information Disclosure Sheet                                 |          |
| 8021                              | 8021         | 40       | 40       | Recording each patent assignment per property (times number of properties) |          |
| 1809                              | 2809         | 770      | 385      | Filing a submission after final rejection (37 CFR § 1.129(a))              |          |
| 1810                              | 2810         | 770      | 385      | For each additional invention to be examined (37 CFR § 1.129(b))           |          |
| 1801                              | 2801         | 770      | 385      | Request for Continued Examination (RCE)                                    |          |
| 1802                              | 1802         | 900      | 900      | Request for expedited examination of a design application                  |          |
| Other fee (specify) _____         |              |          |          |  |          |
| *Reduced by Basic Filing Fee Paid |              |          |          |  |          |
| <b>SUBTOTAL (3)</b>               |              |          |          |  | \$55.00  |

**SUBMITTED BY**

| Name (Print/Type) | Registration No. (Attorney/Agent) | Telephone      |
|-------------------|-----------------------------------|----------------|
| Kawai Lau         | 44,461                            | 858-350-6100   |
| Signature         |                                   | Date           |
|                   |                                   | March 30, 2004 |

Complete (if applicable)

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TOWNSEND and TOWNSEND and CREW LLP

By:   
Pamela Skelton

PATENT

Attorney Docket No. 015280-397100US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

David D. ROBERTS, et al.

Application No.: 10/030,735

Filed: January 9, 2002

For: PEPTIDES AND THEIR UTILITY IN  
MODULATION OF BEHAVIOR OF  
CELLS EXPRESSING  $\alpha\beta 1$   
INTEGRINS

Examiner: Maher M. Haddad

Art Unit: 1644

RESPONSE TO RESTRICTION  
REQUIREMENT

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This is in reply to a Restriction Requirement mailed 30 January 2004, which set 29 February 2004 as the initial deadline for response. Accordingly, a Petition for a one month extension of time until 30 March 2004 is included herewith. This Response is thus believed to be timely filed.

Claims 1-45 are pending and have been restricted. Reconsideration in light of the following amendments and remarks is respectfully requested.

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As an initial matter, Applicants point out that independent claim 37 as well as dependent claims 40, 41, and 42 are not accounted for in the Restriction Requirement as presented. Applicants are thus unsure as to the status of these claims relative to the Restriction Requirement and respectfully request clarification on this issue.

The Restriction Requirement sets forth the following Groups:

Group I, claims 1-10 and 13-14;  
Group II, claims 11-12 and 17;  
Group III, claims 15-16;  
Group IV, claim 18;  
Group V, claims 19;  
Group VI, claims 20-25;  
Group VII, claims 26-28;  
Group VIII, claim 29;  
Group IX, claim 30;  
Group X, claims 31-33;  
Group XI, claims 31 and 33-36;  
Group XII, claims 38, 39 and 43;  
Group XIII, claims 38, 39 and 43;  
Group XIV, claims 38, 39 and 43;  
Group XV, claims 38, 39 and 43;  
Group XVI, claims 38, 39 and 43; and  
Group XVII, claims 43-45.

Furthermore, and on page 4, paragraph 6 of the Restriction Requirement, two requirements for an election of species were presented. With respect to Groups I to XVII, a requirement to elect a species based upon a specific peptide sequence was set forth. With respect to Groups XI to XVI, a requirement to elect an animal was set forth.

The basis for the Restriction Requirement under 35 U.S.C. §§ 121 and 372 is that the inventions of claims 1, 2, 6-9, 13 and 17 allegedly do not present a contribution over the cited

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document by Miles et al. Applicants disagree that Miles et al. constitutes "prior art" as alleged in the Restriction Requirement. Miles et al. is alleged to disclose peptides comprising the sequence DLRL such that the invention of claims 1, 2, 6-9, 13 and 17 do not constitute a special technical feature. The Restriction Requirement thus asserts that the claims lack unity of invention. Applicants respectfully point out that no allegation of lack of unity between claims 1, 2, 6-9, 13 and 17, as a group, and independent claims 11, 14, 15, 20, 26, 29, 30, 37 and 44 has been made.

Without acquiescence to the allegations based on Miles et al., and in the interest of being fully responsive to the Restriction Requirement, Applicants hereby begin by election, with traverse, of a specific peptide sequence of NVRFVF corresponding to positions of  $X_1$ - $X_2$ - $X_3$ - $X_4$ - $R_2$  of the peptide sequence formulas set forth in the claims (where NVRF corresponds to  $X_1$ - $X_2$ - $X_3$ - $X_4$  and VF corresponds to  $R_2$ ). Peptides with this sequence are fully within the scope of the pending claims, and a non-limiting example of a larger peptide comprising this sequence is seen in SEQ ID NO:26. This election is believed to be fully responsive to the requirement for a species election as set forth on page 4 of the Restriction Requirement.

Applicants understand that the requirement for the election of a single species is to facilitate search and examination. If no prior art is found to anticipate or render obvious the elected species, Applicants understand that the search of the claims will be extended to the next species.

With the above election, Applicants respectfully traverse the alleged lack of unity based upon Miles et al., which does not disclose peptides comprising the sequence NVRFVF. Peptides comprising this elected sequence now constitute a special technical feature that provide unity of invention to all claims encompassing such peptides. Applicants believe this to include all the claims of Groups I to XVII. Accordingly, Applicants respectfully request withdrawal of the Restriction Requirement between these Groups in light of the above election.

In the event that the Restriction Requirement is maintained despite the above, Applicants respectfully traverse the restriction of Group I from each of Groups II and III because Group I is related to each as a subcombination to a combination. No basis for restriction according to the standards for combination/subcombination has been presented, and so the

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restriction between these Groups should be withdrawn. The restriction between Group II and each of Groups IV and V, which are also related as subcombination to combination should also be withdrawn.

With respect to Groups VI to IX and XI to XVII, each is essentially a method for the use of a peptide according to at least Group I and so is potentially subject to rejoinder according to the standards set forth at MPEP 821.04. Similarly, Group X is a method for the use of the invention of Group II.

With respect to Groups XII to XVI, inclusive, Applicants respectfully traverse because the restriction appears to ignore the fact that claim 37 is a linking claim that links the inventions of claims 38-43. The Examiner's attention is directed to MPEP 809.03, which details the handling of linking claims. Applicants believe that the division of the claims based upon the disease to be treated (as asserted in the Restriction Requirement) is an assertion of each disease as representing different species.

If the proper existence and status of the linking claims is not recognized, the Examiner will have the ability to denied examination of claims which the Applicants regard as their invention. See *In re Weber* (580 F.2d 455, 198 USPQ 328 (CCPA 1978)) and *In re Haas* (580 F.2d 461, 198 USPQ 334 (CCPA 1978)), and the discussion at MPEP 803.02 in an analogous context. These cases clearly set forth that a restriction requirement cannot be used to divide a single claim, such as a linking claim.

Applicants respectfully traverse for the reasons provided above and request that the Restriction Requirement be withdrawn or at least modified wherein the claims of Group I and at least one of Groups II and III are recombined; the claims of Group II are recombined with at least one of Groups IV and V; and the claims of Groups XII to XVI are recombined.

In the event that the Restriction Requirement is maintained, Applicants elect Group I, claims 1-10 and 13-14, with traverse for the reasons provided above. This election is in combination with the sequence election, with traverse, as stated above.


Applicants reserve the right to pursue the subject matter of any non-elected claim in a subsequent divisional or other continuing application without prejudice.

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If the Examiner believes a telephonic discussion would expedite prosecution of this application, she/he is encouraged to telephone the undersigned at the number provided below.

Respectfully submitted,

  
Kawai Lau, Ph.D.  
Reg. No. 44,461

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, Eighth Floor  
San Francisco, California 94111-3834  
(858) 350-6151  
Fax (415) 576-0300  
KL/ps

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